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(Date)

Paul Marshall

Attorney Docket DP-308846

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Sean M. KELLY et al )  
SERIAL NUMBER: 10/606,849 )  
FILED: June 26, 2003 )  
FOR: INTEGRATED SELF-COOLING )  
PLANT SUPPORT MODULE FOR )  
A FUEL CELL SYSTEM )

) GROUP ART UNIT: 1745  
)  
)  
) EXAMINER: A. Martin

RESPONSE TO RESTRICTION REQUIREMENT UNDER 37 CFR § 1.143

Honorable Commissioner of Patents  
and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is Applicant's response to the Office Action mailed February 23, 2006 having a one-month shortened statutory period for reply.

The Office Action requires restriction between the claims of group I (claims 1-4), group II (claim 5), and group III (claim 6). Applicant provisionally elects the claims of group I (claims 1-4) and acquiesces to the requirement for restriction between groups I and II, and between groups II and III, but respectfully traverses any requirement for restriction between groups I and III.

Applicants first note that the Office Action does not set forth any specific basis for restriction between groups I and III, but to the extent that any such requirement is implied in the Office Action, such requirement is respectfully traversed. The claims of groups I and III are clearly related as subcombination/combination. The framework under which claims in such a

relationship is set forth in MPEP §§ 806.05(a),(c). Under this framework, restriction is proper only if two-way distinctness is found, showing that *both* (a) the combination (claim 6) does not require the particulars of the subcombination (claims 1-4) as claimed for patentability (to show novelty and unobviousness), *and* (b) the subcombination can be shown to have utility either by itself or in another materially different combination. In the present case, part (a) of the test is not satisfied as the combination claim 6 clearly *does* require the particulars of the subcombination claims 1-4 for patentability. Without those particulars, the combination claims would be directed simply to a generic solid oxide fuel cell as is already known in the art.

In view of the above, Applicant respectfully submits that claims 1-4 and 6 do not claim distinct inventions, and that they are properly joined in a single application.

If there are any additional charges or overpayments with respect to this Response, please charge or credit them to Deposit Account No. 50-0831 maintained by Applicants' attorney.

Respectfully submitted,



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